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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/954,988 | 09/15/2001 | Donald W. Hansen JR. | 3366/1 US | 7678 |

26648 7590 04/08/2003

PHARMACIA CORPORATION
GLOBAL PATENT DEPARTMENT
POST OFFICE BOX 1027
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EXAMINER

ZUCKER, PAUL A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1621

11

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,988

Applicant(s)

HANSEN ET AL.

Examiner

Paul A. Zucker

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-203 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 202 is/are allowed.
- 6) ☒ Claim(s) 1-201 and 203 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Current Status

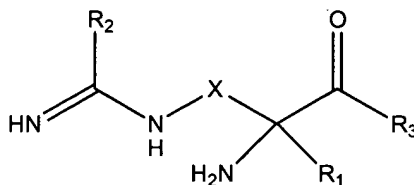
1. This action is responsive to Applicants' amendment and letter of 9 September 2002 and 28 January 2003 in Papers No 7 and 10, respectively.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Applicant's cancellation of claim 204 is acknowledged.
4. Claims 1-203 remain outstanding.
5. The objection to the specification set forth in paragraph 2 of the previous Office Action in Paper No 4 is withdrawn in response to Applicant's amendment.
6. The rejections under 35 USC § 112, second paragraph, set forth in paragraphs 4 - 7 of the previous Office Action in Paper No 4 are withdrawn in response to Applicant's amendment.
7. The rejection under 35 USC § 102(b) set forth in paragraph 8 of the previous Office Action in Paper No 4 is withdrawn in response to Applicants' remarks and in favor of the new rejection below.
8. The rejection under 35 USC § 103(a) set forth in paragraph 6 of the previous Office Action in Paper No 8 is withdrawn in response to Applicants' remarks and in favor of the new rejection below.
9. The rejection for Double Patenting set forth in paragraph 12 of the previous Office Action in Paper No 4 is MAINTAINED because Applicants have not responded to this rejection.

New Rejections

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-12, 19-23, 31-40, 50, 58, 66- 79, 89, 97-107, 114-118, 125,133 –146, 153-156, 164-174, 181-184, 192, 200, 201 and 203 are rejected under 35 U.S.C. 103(a) as being unpatentable over Currie et al (WO 95/25717-A1 10-1995). Currie generically teaches (Page 4, line 1-page 5, line 10) a genus of nitric oxide synthase inhibitors of general formula (I):



Where R₃ may be hydroxyl, R₂ may be methyl and R₁ may be hydrogen or lower alkyl (methyl). A preferred embodiment of the compounds is further taught (Page 7 line 9-21) where X= lower alkenyl and lower alkynyl, where lower denotes 1-6 carbons. All of the compounds Currie exemplifies (See page 23, line 12 –page 24, line 10, for example) have the substitution pattern corresponding to the instant variables R₁ and R₂ where R₁ and R₂ = CH₃. Thus the only selection required is to select an alkylene group for X. Currie provides further guidance (Page 29, lines 27-31) for such selection in claim 4 in which the suggested alkylene subgenus is further narrowed.

Thus the instantly claimed compounds would have been obvious to one of ordinary skill in the art. One of ordinary skill would have been motivated to make the compounds by Currie's teaching that they have activity as nitric oxide synthase inhibitors. Currie provides clear guidance for the selection of the small subgenus of his genus that corresponds to the instantly claimed compounds. There would therefore have been a reasonable expectation for success.

Examiners response to Applicants' Remarks with Regard to This Rejection

Applicants' argue that Currie does not exemplify any compounds containing double bonds and that therefore Currie does not render the instantly claimed compounds unpatentable. The Examiner agrees that Currie does not exemplify any compounds containing double bonds. Currie nevertheless renders the instant compounds unpatentable since clear guidance is provided by Currie for the selection of the instantly claimed subgenus of the compounds taught by Currie.

Applicant's arguments filed 28 January 2003 have been fully considered but they are not persuasive for the reasons indicated above.

Conclusion

11. Claims 1-203 are pending. Claims 1-201 and 203 are rejected. Claim 202 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker
Patent Examiner
Technology Center 1600

April 4, 2003


Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600